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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,199	10/16/2000	Billy P. Taylor	1005.7	2251
53953	7590	05/22/2006		
DAVIS LAW GROUP, P.C. 9020 N. CAPITAL OF TEXAS HWY. BUILDING 1, SUITE 375 AUSTIN, TX 78759			EXAMINER EL CHANTI, HUSSEIN A	
			ART UNIT 2157	PAPER NUMBER

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/690,199	Applicant(s) TAYLOR, BILLY P.	
	Examiner Hussein A. El-chanti	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,15 and 25-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,15 and 25-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/06</u> | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to amendment received on Feb. 28, 2006. Claims 1, 8 and 15 were amended. Claims 25-48 were newly added. Claims 1, 8, 15 and 25-48 are pending examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 31-32, 39-40 and 47-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure of the application does not have a written description that would enable one of the ordinary skill in the art to on a first date, receiving a watch list term that is specified by a user; receiving the electronic version of the paper on a second date after the first date, and searching the electronic version for the watch list term without the user specifying the watch list term after the first date and without the user initiating the searching after the first date; and outputting a result of the searching for display on the display device and in response to a selection of the result, displaying a third portion of the likeness on the display device, wherein the watch list term is located in the third portion as claimed in claims 31-32, 39-40 and 47-48.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 8, 15 and 25-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Baird et al., U.S. Patent No. 6,992,687 (referred to hereafter as Baird).

As to claims 1, 8 and 15, Baird teaches a method performed by a computer system and a program product comprising:

storing an electronic version of a paper, wherein the digital version is displayable on a display device as a likeness of the paper (see col. 4 lines 50-65, electronic version of a book is stored); and

in response to content of a first portion of the likeness forming a hyperlink reference and embedding the hyperlink reference within the first portion of the likeness, wherein the hyperlink reference is associated with a second portion of the likeness such that when the first portion of the likeness is displayed on the display device, at least a portion of the content is selectable by a user to cause the computer system to display the second portion of the likeness on the display device (see col. 7 lines 13-40 and col. 7 lines 60-col. 8 lines 6, bookmarks to other pages are integrated in the first portion to point to other portions of the book), and

wherein the content is at least one of the following: a term that indicates a location at which the second portion of the likeness is located within the paper (see col. 7 lines 60-col. 8 lines 6 and fig. 3 and 4, links include page numbers).

As to claims 25, 33 and 41, Baird teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the content is at least one of the following: a term that indicates a page of the location at which the second portion of the likeness is located within the paper and a phrase that indicates the page (see col. 7 lines 60-col. 8 lines 6 and fig. 3 and 4).

As to claims 26, 34 and 42, Baird teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the content is at least one of the following: a term that indicates a page number of the location at which the second portion of the likeness is located within the paper and a phrase that indicates the page number (see col. 7 lines 60-col. 8 lines 6 and fig. 3 and 4).

As to claims 27, 35 and 43, Baird teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the content is at least one of the following: a term that indicates a title of the location at which the second portion of the likeness is located within the paper and a phrase that indicates the title (see col. 7 lines 60-col. 8 lines 6 and fig. 3 and 4).

As to claims 28, 36 and 44, Baird teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the paper is at least one of the following: a newspaper, a magazine and a journal (see col. 7 lines 60-col. 8 lines 6 and fig. 3 and 4).

As to claims 29, 37 and 45, Baird teaches the method, system and computer readable medium of claims 1, 8 and 15 respectively wherein the electronic version is a first electronic version of the paper and comprising: translating a second electronic version of the paper into the first electronic version (see col. 7 lines 60-col. 8 lines 6 and fig. 3 and 4).

As to claims 30, 38 and 46, Baird teaches the method, system and computer readable medium of claims 1, 8 and 15 comprising highlighting the hyperlink reference (see col. 6 lines 38-65 and fig. 4).

As to claims 31, 39 and 47, Baird teaches the method, system and computer readable medium of claims 1, 8 and 15 comprising:

on a first date, receiving a watch list term that is specified by a user;
receiving the electronic version of the paper on a second date after the first date,
and
searching the electronic version for the watch list term without the user specifying the watch list term after the first date and without the user initiating the searching after the first date; and
outputting a result of the searching for display on the display device (see col. 9 lines 17-37).

As to claims 32, 40 and 48, Baird teaches the method, system and computer readable medium of claims 31, 39 and 47 comprising:

in response to a selection of the result, displaying a third portion of the likeness on the display device, wherein the watch list term is located in the third portion (see col. 9 lines 17-37).

Response to Arguments

4. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2157

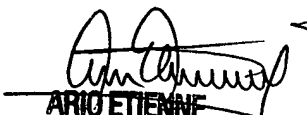
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein Elchanti

May 8, 2006


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
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